

## **REMARKS**

### ***Summary of Changes Made***

By this Amendment, claims 1, 3 and 5-8 have been amended, claims 9 and 10 have been canceled. Claims 2 and 4 were previously canceled. Accordingly, claims 1, 3, and 5-8 (6 claims) remain pending in the application. No new matter is added by this amendment.

### ***Claim Rejections - 35 U.S.C. §102(b)(Mellul)***

In the present Office Action, the Examiner rejected claims 1, 3, and 5-8 under 35 U.S.C. 102(b) as being anticipated by Mellul, U.S. Pat. No. 5,612,021 ("Mellul"). The Examiner's reasoning for the rejections is identical to that in the previous Office Action.

Essentially, the Examiner contends that Mellul teaches a cosmetic composition that includes a wax, a resin and a hollow powder.

The Examiner found unpersuasive the claim amendments requiring the powder to be hollow and the argumentation presented therewith in Applicants' Response filed April 30, 2007. The Examiner will note that claims 1 and 3 have been amended again to recite that the hollow powder is a hollow **resin** powder, and that all remaining claims (5-8) have been amended to depend from claim 1. The resin limitation is the subject matter of claim 9, added to claim 1. Applicants assert the novelty of claim 1, as amended, over Mellul. Mellul fails to disclose all of the limitations of claim 1, i.e., an eyelash cosmetic that includes all three of the elements presently claimed in claim 1 in the amounts claimed in claim 1, and the limitation that the hollow particles be made out of resins (as opposed to fullerenes, as disclosed in Mellul). The hollow particles of Mellul cannot reasonably be equated to the instantly claimed hollow resin powders. As is known in the art, fullerenes are spherical or near-spherical allotropic particles of carbon atoms bonded in certain configurations. The most common fullerene is C60, a truncated icosahedron, having a particle diameter of about 1 (one) nanometer. Larger fullerenes such as C72 and C84 are marginally larger, on the order of a few (<5) nanometers. In contrast, the instantly claimed particles are on the order of 1000 – 10000 times larger, i.e., in the micron range, with several up to 100 microns in diameter, e.g., MFL-100 CA (particle diameter 90 to 110 microns, also in paragraph 17). Clearly, Mellul cannot be said to disclose the same type of particles as instantly claimed. Applicants respectfully request the withdrawal of the rejection.

***Claim Rejections - 35 U.S.C. §103(a)***

The Examiner rejected claims 9 and 10 under 35 U.S.C. 103(a) as obvious in view of Mellul. The Examiner essentially contends that the nature of the hollow powders is immaterial, and that resin or inorganic hollow powders are obvious variants of the hollow fullerene particles disclosed in Mellul.

The Examiner will note that claims 9 and 10 have been canceled thus rendering the rejections thereof moot. While the subject matter of claim 9 has been added to claim 1, from the discussion above, it is clear that the instantly claimed hollow resin powders are on the order of 1000 - 10000 times larger than the hollow particles of Mellul. It would not be obvious to one skilled in the art that particles having a size difference of 1000 times or more would be useful in the same application. Applicants respectfully submit that claim 1, as amended, as well as all claims that depend therefrom, are also non-obvious in view of Mellul.

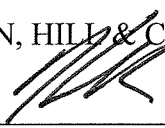
## **CONCLUSION**

In light of the foregoing, Applicants respectfully request that the amendment be entered into the record and considered. Applicants respectfully submit that the present application, including claims 1, 3, and 5-8, is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 18-0160, our Order No. IWI-16232.

Respectfully submitted,

RANKIN, HILL & CLARK LLP



---

Kenneth A. Clark  
Reg. No. 32,119  
Christopher J. Korff  
Reg. No. 55,342

925 Euclid Avenue  
Suite 700  
Cleveland, Ohio 44115-1405  
(216) 566-9700